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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,945	04/26/2000	Jonathan Kepecs	018477-000510US	3005
51111	7590	12/06/2005	EXAMINER	
AKA CHAN LLP 900 LAFAYETE STREET SUITE 710 SANTA CLARA, CA 95050			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/558,945	<b>Applicant(s)</b> KEPECS, JONATHAN	
	<b>Examiner</b> JAGDISH PATEL	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-27 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-27, 36-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to amendment response filed 9/27/05.

### **Response to Amendment**

2. Claims 1-17, 19-27, 36-48 are pending. Claims 1, 20, 36, and 46 have been amended per request.

### ***Specification***

3. The amendment filed 9/27/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Claims 1-17, 19-27 and 37-48:

“determining, using the at least one computer network system, whether said identified consumer has made an acknowledgement of said promoting within the predetermined time period, said acknowledgement not including an attempt by said identified consumer to purchase said first selected item;”

(the specification recites at line 29+ of page 7 “An acknowledgement might be the act of browsing through the webpage or a positive response to accept the promotion offer might be required.” The specification teaches that the acknowledgement might be at least one of the aforementioned actions, i.e. browsing or a positive response. However,

Art Unit: 3624

the specification fails to teach that the acknowledgement by the consumer does not include an attempt (by the consumer) to purchase the selected product)

“prolonging, using the at least one computer network system, the promoting beyond the predetermined time period upon determining that said consumer has made the acknowledgement of said promoting within the predetermined period.”

(the specification is silent about the manner in which the prolonging of the promotion (delay the termination of the inverted promotion, page 7 L 33-34) is carried out in terms of the acknowledgement, in particular, the specification fail to teach that the prolonging is based on the acknowledgment as defined in the claim limitation. The specification teaches that the prolonging is done whenever there is acknowledgment of the promotion by the consumer)

Claim 36: “determining when said computer network system is not in normal operation..”. wherein responsive to said determining, said method further comprising: “recording by said computer network a price paid for said first selected item by said consumer at a location.”

This feature is not disclosed in the specification. At paragraph line 14+ on page 10 the specification recites when the computer server handling the promotion is down, ...the consumer cannot receive the special discount or price of ..inverted promotion.” The specification is silent about determining the condition or status of the computer network and recording by the computer network a price paid for in response to such determining.

*Specification*

4. 37 CFR 1.71. Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

5. In regards to the specific requirements outlined above, the specification does not describe completely a specific embodiment of claims 1-17, 19-27 and 36-48 in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same. In particular, the specification fails to describe limitation of claimed invention “prolonging, using the at least one computer network system, the promoting beyond the predetermined time period upon determining that said consumer has made the acknowledgement of said promoting within the predetermined period.” per independent claims 1. There is no reference in the specification as originally filed regarding (i) determining that the acknowledgement is caused by an event that does not include an attempt by the identified consumer to purchase the item and (ii) that the prolonging (holding cancellation of the promotion in abeyance or delay the termination of the inverted promotion, p.7 L 29-34) is solely based upon the acknowledgement that does not include an attempt to purchase the selected product. The specification teaches that the promotion is prolonged regardless of how the selected consumer has acknowledged the promotion, i.e.

Art Unit: 3624

whether browsing through the webpage or a positive response to accept the promotion offer (i.e. an attempt to purchase the product). In other words, the specification does not distinguish, the act of prolonging of promotion solely based upon the acknowledgement that does not include an attempt by the consumer to purchase the selected item (i.e. via mere act of browsing through the webpage).

6. Regarding claim 36, the specification fails to teach “determining when said computer network system is not in normal operation..”. wherein responsive to said determining, said method further comprising:

“recording by said computer network a price paid for said first selected item by said consumer at a location.”

The specification is silent about determining that the computer network is not “normal operation” and responsive to that determination recording a price paid for said first selected item by said consumer at a location.

***Claim Rejections - 35 USC § 112 (First)***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-17, 19-27, 36-45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

Art Unit: 3624

had possession of the claimed invention. In particular, claims are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

***Claim Rejections - 35 USC § 112 (Second)***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 recites “determining when said computer network system is not in normal operation..”. wherein responsive to said determining, said method further comprising:

“recording by said computer network a price paid for said first selected item by said consumer at a location.”

It is unclear, how the computer network when not in (normal) operation can record a price paid by a consumer.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3624

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jagdish N. Patel

(Primary Examiner, AU 3624)

11/30/05